

REMARKS

Reconsideration and withdrawal of the objections to and rejections of the application are requested in view of the amendments and remarks herewith, which are believed to place the application into condition for allowance.

The Examiner is thanked for courtesies extended during an informal telephone conference with the Applicants' representative on December 10, 2003.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 46-50, 52-56 and 58-78 are pending in this application. Claims 46-50, 52-56, 58-60, 62 and 64 are amended; claims 65-78 are added; and claims 1-45, 51 and 57 have been cancelled. Support for the added and amended claims can be found throughout the specification and from the claims as originally filed. Particular support for 30 contiguous nucleotides in claims 46 and 74, 10-250 contiguous nucleotides in claims 58 and 59, 15-30 contiguous nucleotides in claim 67, 15 contiguous nucleotides in claim 68, and 250 contiguous nucleotides in claim 75 can be found, for example, on page 8, lines 11-12 and on page 14, lines 30-31. Support for 90% homology in claim 70 can be found on page 8, line 7. The remaining amendments address formalities and do not affect scope. The remaining added claims correspond with previously pending claims. No new matter is added.

Claim 60 was objected to as being dependent upon a rejected base claim. The Examiner is thanked for indicating that claim would be allowable if rewritten in independent form. Claim 60 has been rewritten in independent form, and is therefore allowable.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art, and that these claims are and were in full compliance with the requirements of 35 U.S.C. §112. The amendments of and additions to the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicant is entitled. Furthermore, it is explicitly stated that the herewith amendments should not give rise to any estoppel, as the herewith amendments are not narrowing amendments.

II. THE REJECTIONS UNDER 35 U.S.C. §112, 1ST PARAGRAPH ARE OVERCOME

Claims 47-51 were rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking adequate written description. The rejection was a new matter rejection. Claims 47-50 have been

amended to recite particular sequences disclosed in the specification, and claim 51 has been cancelled, thereby obviating the rejection.

Claims 46-59 and 61-64 were rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking adequate written description. The rejection is traversed.

Claims 46-55 have been amended such that they now recite the transition “consisting of”, rather than comprising, overcoming the rejection of those claims on this basis. Claim 56 is directed to a kit “comprising” one or more polynucleotides of claims 46-50. The amendments to claims 46-50 should overcome the rejection of this claim as well, since the rejection was directed toward the nucleotides themselves. The kit can contain other components, hence the open language has been maintained.

Claims 58 and 59 have been amended to recite an upper limit on the size of the first polynucleotide, and claim 59 has also been amended to recite an upper limit on the size of the second polynucleotide. Since these are method claims, Applicants do not believe that it is necessary to restrict the polynucleotide to a sequence “consisting of” 10 to 250 contiguous nucleotides, as any size polynucleotide can be used in the claimed methods, provided that it contains the right sequence (*i.e.*, one which hybridizes to *Pseudomonas* DNA).

The Office Action alleges that “the specification has not taught that SEQ ID NO:1 is the full-length 23s-5s intergenic spacer for *Pseudomonas aeruginosa*.” Applicants disagree and submit that it is clear from the specification that SEQ ID NO:1 is the full length intergenic region; however, attached is a Declaration under 37 CFR 1.132 by Cornelia Berghof-Jäger (formerly Cornelia Berghof), an inventor of this application, attesting to that fact.

The claims are believed to comply with the requirements of 35 U.S.C. §112, first paragraph. Consequently, reconsideration and withdrawal of the rejections are requested.

III. THE REJECTION UNDER 35 U.S.C. §112, 2ND PARAGRAPH IS OVERCOME

Claims 58-64 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. The Office Action alleges that the steps of the claimed methods are unclear. Claims 58-60 have been amended for clarity and to relate the steps of the method back to the preamble. The rejection is believed to be overcome, and reconsideration and withdrawal are requested.

IV. THE REJECTIONS UNDER 35 U.S.C. §102 ARE OVERCOME

Claims 46, 47, 52, 53 and 55 were rejected under 35 U.S.C. §102(a) as allegedly being anticipated by EST accession number AA535879. The rejection is traversed.

This accession number relates to a sequence that comprises nucleotides 1-16 of SEQ ID NO:3. Claim 46 is directed to a polynucleotide consisting of 30 contiguous nucleotides of SEQ ID NO:1, and claim 47 is directed to a polynucleotide consisting of SEQ ID NO:3. Therefore, claims 46, 47 and their dependent claims fall outside of EST accession number AA535879.

Claims 58 and 62 were rejected under 35 U.S.C. §102(b), as allegedly being anticipated by Mäntynen *et al.* The rejection is traversed.

Mäntynen *et al.* relates to the detection of *Staphylococcus aureus*, and not *Pseudomonas*, as is claimed in claims 58 and 62. Furthermore, Mäntynen *et al.* is not a proper §102(b) reference, as it was published in May, 1997, less than one year before the earliest priority date of the instant application, which is September 9, 1997. A facsimile copy of a certified copy of priority application DE 197 39 611.9 and a certified English translation are attached. The original certified copies will be forwarded to the Examiner's attention upon their receipt by the undersigned.

It is submitted that the claims are not anticipated by either EST accession number AA535879 or Mäntynen *et al.* Reconsideration and withdrawal of the rejections under 35 U.S.C. §102 are requested.

V. THE REJECTIONS UNDER 35 U.S.C. §103 ARE OVERCOME

Claims 56 and 57 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Mäntynen in view of Ahern. The rejection is traversed.

Claim 57 has been cancelled, and claim 56 has been amended such that the claimed kit includes one or more of the polynucleotides of claims 46-50. None of these polynucleotides is taught or suggested by Mäntynen or Ahern. In addition, as discussed above, Mäntynen *et al.* is not a proper prior art reference.

As the cited references, alone or in combination, do not teach, suggest or enable the claimed invention, reconsideration and withdrawal of the rejections under 35 U.S.C. §103 are requested.

CONCLUSION

Applicants believe that the application is in condition for allowance, and favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. Alternatively, consideration and entry of this paper are requested, as it places this application into better condition for purposes of appeal.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicant

By: Anne-Marie C. Yvon
Ronald R. Santucci
Registration No. 28,988
Samuel H. Megerditchian
Registration No. 45,678
Anne-Marie C. Yvon, Ph.D
Registration No. 52,390
(212) 588-0800